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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,438	01/23/2004	Andrew M. Hatch	HSTI 0135	6831
35312	7590	07/18/2006	PUS1/H50006AHST	
BROOKS KUSHMAN P.C./ HENKEL CORPORATION 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075-1238			EXAMINER DOUYON, LORNA M	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,438

Applicant(s)

HATCH ET AL.

Examiner

Lorna M. Douyon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 53-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3 pages.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-14, 16-52 in the reply filed on May 1, 2006 is acknowledged. The traversal is on the ground(s) that claim 15 (Group II) is dependent upon claim 1 and can readily be searched and examined with claim 1. (Please note that there were 3 groups in the restriction requirement.) This is not found persuasive because, as stated in the previous action, the metallic article of claim 15 (Group II) and the cleaning composition of Group I have a separate status in the art in view of their different classification, hence would give burden to the examiner in searching 2 distinct inventions.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-63 are pending. Claims 15, 53-63 are withdrawn from consideration as being drawn to non-elected invention.

Claim Rejections - 35 USC § 112

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is indefinite in the recital of "ethoxylate having Formula R_1-OH " in line 2, because the formula is for the alcohol and not the ethoxylate. Did Applicant mean "the ethoxylate of an alcohol having Formula R_1-OH ?"

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 7, 9, 16, 17, 19, 20, 24, 26-29, 33 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Bershas et al. (US Patent No. 5,476,601), hereinafter “Bershas”.

Bershas ‘601 teaches a lubricant and surface conditioner forming component in deionized water, comprising of about 1% active organic (I), about 0.2 % inorganic (II) and about 0.5% surfactant (III) (see col. 18, lines 60-67), wherein (I) is oleyl [POE(15)] ammonium chloride, (II) is $\text{Fe}_2(\text{SO}_4)_3$, and (III) is Neodol 25-9 (a C_{12-15} ethoxylated alcohol having 9 moles ethoxylate group) having a pH of 2.0 (see Table 7, cols. 21-22, see Example Type A; second named component). The aqueous component should inherently possess a water break-free percent reduction and a cloud point within those recited because same ingredients have been utilized. The aqueous component should be capable of cleaning an exterior wall of an aluminum can in the manner set forth in claims 3 and 19 because it has been held that the recitation that an element is “adapted to” perform or is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. The recitation of a new intended use for an old product does not make a claim to that old product patentable, see *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Hence, Bershas anticipates the claims.

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6. Claims 1-4, 7, 9, 16, 17, 19, 20, 24, 26-29, 33 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Banaszak et al. (US Patent No. 5,584,943), hereinafter "Banaszak".

Banaszak teaches a lubricant and surface conditioner forming component in deionized water, comprising of about 1% active organic (I), about 0.2 % inorganic (II) and about 0.5% surfactant (III) (see col. 16, lines 15-20), wherein (I) is oleyl [POE(15)] ammonium chloride, (II) is $\text{Fe}_2(\text{SO}_4)_3$, and (III) is Neodol 25-9 (a C_{12-15} ethoxylated alcohol having 9 moles ethoxylate group) having a pH of 2.0 (see Table 5, cols. 17-18, see Example Type A; 9th named component). The aqueous component should inherently possess a water-break-free percent reduction and a cloud point within those recited because same ingredients have been utilized. The aqueous component should be capable of cleaning an exterior wall of an aluminum can in the manner set forth in claims 3 and 19 because it has been held that the recitation that an element is "adapted to" perform or is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. The recitation of a new intended use for an old product does not make a claim to that old product patentable, see *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Hence, Banaszak anticipates the claims.

7. Claims 1-3, 9, 12, 14, 16, 17, 19, 26-28, 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshowski et al. (US Patent No. 4,960,588), hereinafter "Hoshowski".

Hoshowski teaches an emulsion/conditioner for hair which comprises 0.3 wt% ethoxylated (23) lauryl alcohol (having 23 moles of ethoxy groups, and which reads on component A of the present claims, R=12), 5.7 wt% ethoxylated (4) lauryl alcohol (which reads on component C of the present claims), hydrochloric acid (HCl) to adjust the pH to 2.7-4.5, and

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the balance water (see Example II, col. 14, lines 36-52). The word “about” permits some tolerance. At least about 10% was held to be anticipated by a teaching of a content not to exceed about 8%, see *In re Ayers*, 154 F 2d 182, 69 USPQ 109 (CCPA 1946). A pressure limitation of 2-15 pounds per square inch was held to be readable on a reference which taught a pressure of the order of about 15 pounds per square inch, see *In re Erickson*, 343 F 2d 778, 145 USPQ 207 (CCPA 1965). Hence, 0.3 wt% ethoxylated (23) lauryl alcohol of Hoshowski reads on the “about 0.05 gram/liter or about 0.5 wt% ethoxylate of an alcohol” of present claim 16. Even though Hoshowski does not teach a cleaning metal article use of his composition, the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau*, 57 USPQ 324; *Ex parte Douros*, 163 USPQ 667; and *In re Craige*, 89 USPQ 393. The emulsion/conditioner should inherently possess a water-break-free percent reduction and a cloud point within those recited because same ingredients have been utilized. The emulsion/conditioner should be capable of cleaning an exterior wall of an aluminum can in the manner set forth in claims 3 and 19 because it has been held that the recitation that an element is “adapted to” perform or is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. The recitation of a new intended use for an old product does not make a claim to that old product patentable, see *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Hence, Hoshowski anticipates the claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-14 and 16-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US Patent No. 6,214,777), hereinafter "Li".

Li teaches a lubricant composition which is used to treat or lubricate containers (see col. 1, lines 8-10), like aluminum cans (see col. 8, line 66), which comprises neutralizing agents, surfactants, water and water-conditioning agents (see col. 6, lines 41-43). Useful neutralizing agents include the alkali metal hydroxides and are present in an amount to adjust the pH of the composition to a range of about 3 to about 9.5 (see col. 6, lines 44-57). Suitable surfactants include nonionic surfactants and anionic surfactants (see col. 6, lines 59-67). Particularly suitable nonionic surfactants are the alkoxylated alcohols having the general formula $R^{10}O((CH_2)_mO)_n$ wherein R^{10} is an aliphatic group having from about 8 to about 24 carbon atoms, m is a whole number from 1 to about 5, and n is a number from 1 to about 40 which represents the average

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number of ethylene oxide groups on the molecule (see col. 7, lines 18-25), and can be used in an amount of about 0.5 to about 30 percent by weight of the composition (see col. 7, lines 26-30). Other surfactants include sulfates, ethoxylated alkylphenols and polyoxyalkylene oxide block copolymers (see col. 7, lines 1-17). Generally, the total surfactant concentration ranges from about 1 wt% to 50 wt% (see col. 7, lines 50-53). In Example 1, Li teaches a lubricating composition comprising water, 5 wt% didecyl dimethyl ammonium chloride (another surfactant), 2.5 wt% polyethylene phenol ether phosphate, 8 wt% linear alcohol 60-70% ethoxylate and 2 wt% sodium hydroxide 50% (see Example 1 #1 in col. 10, lines 1-16). Li, however, fails to specifically disclose a composition wherein the linear alcohol ethoxylate has an alkyl group and ethoxy group as those recited, the water-break-free percent reduction and cloud point of the composition as those recited.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In addition, a *prima facie* case of obviousness exists because the claimed ranges "overlap or lie inside ranges disclosed by the prior art", see *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976; *In re*

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Woodruff, 919 F.2d 1575, 16USPQ2d 1934 (Fed. Cir. 1990). See MPEP 2131.03 and MPEP 2144.05I. With respect to the water-break-free percent reduction and cloud point of the composition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect said properties to be within those recited because similar ingredients have been utilized.

Conclusion

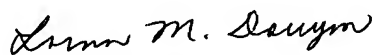
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered cumulative to or less material than those discussed above.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is (571) 272-1313. The examiner can normally be reached on Mondays-Fridays from 8:00AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Lorna M. Douyon
Primary Examiner
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